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Attorneys for Plaintiff

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF WASHINGTON

UPPER COLUMBIA
MEDIA ASSOCIATION

Plaintiff,

v.

OLIVET NAZARENE UNIVERSITY

Defendant.

Civil Action No.

COMPLAINT

Jury Trial Demanded

COMPLAINT: 1

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9/25/23

1
2 Plaintiff Upper Columbia Media Association (“Plaintiff”), by and through
3 its undersigned counsel, for its complaint against Defendant Olivet Nazarene
4 University (“Defendant”), hereby alleges and states the following:
5

6 **NATURE AND BASIS OF ACTION**

7 1. This is an action under the Declaratory Judgment Act, 28 U.S.C.
8 §2201 and §2202, seeking a declaration that Plaintiff’s registration and use of the
9 marks SHINE 104.9 and SHINE FEST (“Plaintiff’s Marks”) does not infringe upon
10 Defendant’s alleged rights in the mark SHINE (“Defendant’s Alleged SHINE
11 Mark”) or constitute unfair competition or false designation of origin under the
12 Lanham Act, and that Plaintiff’s registration and use of the domain name
13 <shine1049.org> does not constitute cybersquatting under the Lanham Act.
14

15
16 2. This action arises out of Defendant’s filing of a Petition for
17 Cancellation of Plaintiff’s U.S. Reg. Nos. 6,045, 426 and 6,045,559 for Plaintiff’s
18 Marks with the Trademark Trial and Appeal Board on April 10, 2023 (attached as
19 Exhibit 1) and Defendant’s subsequent demands in an September 6, 2023 e-mail to
20 Plaintiff (Exhibit 2), which included a complaint for trademark infringement that
21
22
23

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1 Plaintiff threatened to file in U.S. District Court if Defendant did not cease its use
2 of Plaintiff's Marks (Exhibit 3).

3
4 **THE PARTIES**

5 3. Plaintiff Upper Columbia Media Association is a Washington
6 nonprofit corporation with a place of business at 3715 South Grove Road, Spokane,
7 Washington, 99224.

8 4. Upon information and belief, Defendant Olivet Nazarene University
9 is an Illinois not-for-profit corporation with a place of business at 1 University Ave,
10 PO 592, Bourbonnais, Illinois, 60140.

11
12 **JURISDICTION**

13 5. This action arises out of the Declaratory Judgment Act, 28 U.S.C.
14 §2201 and §2202, and the Lanham Act, 15 U.S.C. §1051 et seq. This court thus
15 has original jurisdiction over the subject matter of this action pursuant to 28
16 U.S.C. §1331 and §1338.

17 6. Defendant is subject to the personal jurisdiction of this Court
18 because Defendant has availed itself of the rights and benefits of the State of
19 Washington, has regularly conducted business in the State of Washington, and
20 has systematic and continuous business contacts with the State of Washington.
21
22
23

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1 Furthermore, Defendant's false assertions of trademark infringement were
2 directed to Plaintiff in the State of Washington. This Court thus has both general
3 and specific personal jurisdiction over Defendant.
4

5 7. Venue is proper in this district pursuant to 28 U.S.C. § 1391, since a
6 substantial part of the events giving rise to the claims against Defendants
7 occurred in this District.
8

9 **FACTUAL BACKGROUND**

10 8. Plaintiff is a media company affiliated with the Seventh-day Adventist
11 Church and is a subsidiary of the Upper Columbia Conference of Seventh-day
12 Adventists. The Conference is an administrative unit of the Seventh-day Adventist
13 Church serving eastern Washington and northern Idaho.
14

15 9. Plaintiff owns several radio stations in eastern Washington and
16 northern Idaho that broadcast Christian programming, including a station in
17 Spokane, Washington that broadcasts under the call sign KEEH.
18

19 10. Plaintiff's radio station KEEH began broadcasting in 1993.
20

21 11. The radio signal broadcast by Plaintiff's KEEH and its other radio
22 stations can generally only be received over the air in the Spokane, Washington
23 metropolitan area and in parts of Eastern Washington and Northern Idaho, although

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1 consumers can also listen to the station through Plaintiff's web site at
2 <shine1049.org> or through Plaintiff's "Shine 104.9 – KEEH" mobile application
3 or various other online radio web sites and applications. Plaintiff states in its
4 programming that it provides "Christian music for Spokane and North Idaho."
5

6 12. In early 2016, Plaintiff began using the name and mark SHINE 104.9
7 in connection with Plaintiff's radio station KEEH.

8 13. Defendant is a private Christian university located in Bourbonnais,
9 Illinois. Upon information and belief, Defendant is affiliated with the Church of
10 the Nazarene.
11

12 14. Upon information and belief, Defendant is the owner of the radio
13 station WONU, which broadcasts on the frequency 88.3. Upon information and
14 belief, Defendant brands its WONU radio station as "Shine FM."
15

16 15. Upon information and belief, the signals from Defendant's Shine FM
17 radio stations can generally only be received over the air in Northeastern Illinois,
18 Northwestern and North Central Indiana, and the Lansing, Michigan metropolitan
19 area, although Defendant also claims to transmit its radio programming over the
20 Internet.
21
22
23

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THE PARTIES' MARKS

16. Defendant obtained a trademark registration for the mark SHINE.FM in connection with “educational and entertainment services, namely, production and distribution of radio programs for others” in March of 2012 (U.S. Reg. No. 4,113,384).

17. Defendant uses its SHINE.FM mark in a distinctive logo format, as shown below:



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1 18. Plaintiff began using the name and mark SHINE 104.9 in early 2016,
2 at which time Plaintiff had no knowledge of Defendant or of Defendant's alleged
3 rights in Defendant's Alleged SHINE Mark.
4

5 19. Plaintiff uses its SHINE 104.9 mark in combination with a highly
6 distinctive logo, as shown below ("Plaintiff's SHINE 104.9 Logo Mark"), which
7 is entirely different from the logo used by Defendant for Defendant's Alleged
8 SHINE Mark:
9



20 20. Plaintiff has been using Plaintiff's SHINE 104.9 Logo Mark
21 continuously since 2016, with no instances of consumer confusion with
22 Defendant's Alleged SHINE Mark or any other mark.
23

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1 21. Plaintiff filed a trademark application with the United States Patent
2 and Trademark Office on April 23, 2019 to register Plaintiff's SHINE 104.9 Logo
3 Mark in connection with "production of radio programs" in Class 41.

4
5 22. The USPTO did not cite Defendant's Alleged SHINE Mark or any
6 other prior marks as bars to registration of Plaintiff's SHINE 104.9 Logo Mark,
7 and issued a Certificate of Registration for Plaintiff's SHINE 104.9 Logo Mark to
8 Plaintiff on May 5, 2020.

9
10 23. Plaintiff also uses the mark SHINE FEST in connection with an
11 annual music festival in Spokane, Washington featuring live public performances
12 by contemporary Christian singers, musicians, and speakers.

13 24. Plaintiff also uses the SHINE FEST mark as a highly distinctive logo
14 ("Plaintiff's SHINE FEST Logo Mark"), which is likewise completely different
15 from the logo used by Defendant for Defendant's Alleged SHINE Mark:
16



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1 25. Plaintiff has been using its SHINE FEST Logo Mark continuously
2 since 2016, with no instances of actual confusion with Defendant's Alleged SHINE
3 Mark or any other mark.
4

5 26. Plaintiff filed a trademark application with the United States Patent
6 and Trademark Office on May 28, 2019 to register Plaintiff's SHINE FEST Logo
7 Mark in connection with "producing and staging an annual music festival featuring
8 live public performances by contemporary Christian singers, musicians, and
9 speakers" in Class 41.
10

11 27. Again, the USPTO did not cite Defendant's Alleged SHINE Mark as
12 a bar to registration of Plaintiff's SHINE FEST Logo Mark, and issued a Certificate
13 of Registration for the Plaintiff's SHINE FEST Logo Mark to Plaintiff on May 5,
14 2020.
15

16 28. The term "Shine" is extremely weak and diluted in connection with
17 radio production and broadcasting services, and there are numerous third parties
18 using marks containing "Shine" in connection with radio production and
19 broadcasting services and closely related goods and services.
20

21 29. Plaintiff's Marks are distinguishable from Defendant's Alleged
22 SHINE Mark in appearance, pronunciation, and commercial impression, due to the
23

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1 addition of the terms 104.9 and FEST in Plaintiff's Marks and the significant
2 differences in the distinctive logos used by the parties.

3 30. The parties' geographic markets are completely different and do not
4 overlap.
5

6 31. Consumers of both parties' services are knowledgeable and
7 sophisticated and exercise a high degree of care in determining which radio station
8 to listen to.
9

10 32. The parties have been using their respective marks
11 contemporaneously for at least seven years with zero instances of actual consumer
12 confusion.

13 33. The USPTO reviewed Plaintiff's trademark applications for Plaintiff's
14 Marks and concluded that Plaintiff's Marks were not confusingly similar to any
15 previously registered marks, including Defendant's Alleged SHINE Mark.
16

17 34. As a result of the factors listed in Paragraphs 28-34, and other factors,
18 Plaintiff's Marks are not confusingly similar to Defendant's Alleged SHINE Mark.
19

20 **DEFENDANT'S ACTS COMPRISING ACTUAL CONTROVERSY**

21 35. On April 10th, 2023, Defendant filed a Petition for Cancellation with
22 the Trademark Trial and Appeal Board, seeking the cancellation of Plaintiff's U.S.
23

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1 Reg. Nos. 6,045, 426 and 6,045,559 for Plaintiff's Marks. The Petition for
2 Cancellation alleged that "[Plaintiff's] marks SHINE 104.9 and SHINE FEST,
3 when used in connection with the services set forth in the registration, are likely to
4 cause confusion, mistake, or to deceive as to the origin, source, sponsorship or
5 affiliation of Registrants' services within the meaning of 15 U.S.C. 1052(d)."¹
6

7 36. Plaintiff's counsel and Defendant's counsel had a telephone call on
8 July 5, 2023 in which Plaintiff's counsel explained that the parties' marks had
9 peacefully coexisted for nearly seven years and expressed Plaintiff's belief that the
10 parties' marks could continue to coexist. Defendant's counsel stated that he would
11 discuss the terms of a possible coexistence agreement with Defendant and revert to
12 Plaintiff shortly.
13

14 37. However, on August 16, 2023 Defendant's counsel sent an e-mail to
15 Plaintiff's counsel in which Defendant's counsel stating that Defendant was
16 unwilling to consider a coexistence agreement, and demanding that Plaintiff begin
17 rebranding away from the SHINE mark (Exhibit 4).
18
19
20

21 ¹ The Petition also alleged that Plaintiff had committed fraud on the USPTO, but
22 this claim was dismissed after Plaintiff filed a Motion to Dismiss.
23

1 38. On September 6, 2023, Defendant's counsel sent another e-mail to
2 Plaintiff's counsel in which Defendant's counsel stated that Defendant was
3 "committed" to litigating this dispute against Plaintiff if necessary (Exhibit 2).
4 Defendant's counsel also attached a complaint against Plaintiff in U.S. District
5 Court alleging trademark infringement, unfair competition, false designation of
6 origin, cybersquatting, and violation of state laws, and requesting injunctive relief,
7 monetary damages, and attorneys' fees (Exhibit 3).
8

9 39. The filing of the Petition for Cancellation, along with the sending of a
10 fully realized complaint alleging trademark infringement, unfair competition, and
11 cybersquatting, clearly and unambiguously demonstrate Defendant's intent to take
12 legal action to enforce its alleged trademark rights.
13

14 40. There is currently a justiciable controversy regarding Plaintiff's right
15 to use and register Plaintiff's Marks free from any allegation by Defendant that
16 such conduct constitutes an infringement of Defendant's purported trademark
17 rights.
18

19 //

20 //

21 //

22
23
COMPLAINT: 12

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COUNT I

DECLARATORY JUDGMENT OF NON-INFRINGEMENT

41. Plaintiff repeats and re-alleges each and every allegation contained in Paragraphs 1 through 40 of this Complaint and incorporates them herein by reference.

42. There is an actual and justiciable controversy by way of the credible threat of immediate litigation by Defendant against Plaintiff to enforce Defendant's alleged trademark rights.

43. Plaintiff's Marks are not confusingly similar to Defendant's Alleged SHINE Mark due to the weak nature of the mark, the differences in the parties' geographic market areas, the sophistication of the relevant consumers, the lack of actual confusion despite numerous years of coexistence, and other factors.

44. Plaintiff is entitled to a declaratory judgment stating that it is not infringing, has not infringed, and is not liable for infringing Defendant's Alleged SHINE Mark or any other allegedly enforceable trademark owned by Defendant in violation of the Lanham Act, 15 U.S.C. §1114.

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COUNT II

**DECLARATORY JUDGMENT OF
LACK OF UNFAIR COMPETITION AND/OR FALSE DESIGNATION
OF ORIGIN**

45. Plaintiff repeats and re-alleges each and every allegation contained in Paragraphs 1 through 40 of this Complaint and incorporates them herein by reference.

46. There is an actual and justiciable controversy by way of the credible threat of immediate litigation by Defendant against Plaintiff to enforce Defendant's alleged trademark rights.

47. Plaintiff's Marks are not confusingly similar to Defendant's Alleged SHINE Mark due to the weak nature of the mark, the differences in the parties' geographic market areas, the sophistication of the relevant consumers, the lack of actual confusion despite numerous years of coexistence, and other factors.

48. Plaintiff is entitled to a declaratory judgment stating that it has not committed unfair competition or false designation of origin under the Lanham Act, 15 U.S.C. 1125(a).

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COMPLAINT: 14

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COUNT III

DECLARATORY JUDGMENT OF NO CYBERSQUATTING

49. Plaintiff repeats and re-alleges each and every allegation contained in Paragraphs 1 through 40 of this Complaint and incorporates them herein by reference.

50. There is an actual and justiciable controversy by way of the credible threat of immediate litigation by Defendant against Plaintiff alleging a claim for violation of the Anticybersquatting Consumer Protection Act, 15 U.S.C. 1125(d).

51. Plaintiff's <shine1049.org> domain name is not confusingly similar to Defendant's Alleged SHINE Mark, due to the weak nature of the mark, the differences in the parties' geographic market areas, the sophistication of the relevant consumers, the lack of actual confusion despite numerous years of coexistence, and other factors.

52. Plaintiff had no knowledge of Defendant's Alleged SHINE Mark when it registered and began using the <shine1049.org> domain name.

53. Plaintiff had no bad faith intent to profit from the <shine1049.org> domain name when it registered and began using the domain name, and has no bad faith intent to profit from the <shine1049.org> domain name today.

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1 54. Plaintiff is entitled to a declaratory judgment stating that it has not
2 committed cybersquatting under the Lanham Act, 15 U.S.C. 1125(d).

3
4 **JURY DEMAND**

5 Plaintiff demands a trial by jury of all issues so triable.

6 **PRAYER FOR RELIEF**

7 WHEREFORE, Plaintiff prays that the Court enter judgment in its favor
8 and grant the following relief:

- 9
10 A. An order declaring that Plaintiff has not infringed any valid,
11 distinctive, and enforceable trademark owned by Defendant;
12
13 B. An order declaring that Plaintiff has not committed unfair
14 competition or false designation of origin;
15
16 C. An order declaring that Plaintiff has not committed cybersquatting
17 by virtue of its registration and use of the domain name <shine1049.org>;
18
19 D. An order awarding attorneys' fees, costs, and expenses incurred in
20 connection with this action to Plaintiff; and
21
22 E. An order awarding such other and further relief, at law or in equity
23 as this Court deems just and proper.

1 DATED this 25th day of September, 2023.

2 LUKINS & ANNIS, P.S.

3
4
5 By: /s/ Reid G. Johnson

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COMPLAINT: 17

9/25/23

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